

REMARKS

The examiner has rejected claims 23-51 under 35 U.S.C. 251 as being improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present application is based. The examiner is urged to reconsider and withdraw the rejection.

The examiner's statement of the doctrine of recapture is not consistent with the Manual for Patent Examining Procedure (Section 1412.02). The situation before us is one in which the reissue claims are broader in scope in some aspects, but narrower in others. The MPEP provides as follows:

If the broadening aspect of the reissue claim relates to subject matter previously surrendered, the examiner must determine whether the newly added narrowing limitation in the reissue claim modifies the claim such that the scope of the claim no longer results in a recapture of the surrendered subject matter. If the narrowing limitation modifies the claim in such a manner that the scope of the claim no longer results in a recapture of the surrendered subject matter, then there is no recapture. In this situation, even though a rejection based on recapture is not made, the examiner should make of record the reason(s) why, as a result of the narrowing limitation, there is no recapture.

The examiner has recited three aspects in which claim 23 has been broadened over claim 15 of the original application (claim 16 of the issued patent).

The first broadening aspect noted is that claim 23 does not require that the electrode be contained within the compartment. The examiner points to the second element of the claim, which refers to the compartment being sized and configured to enclose the electrode, but not to the electrode actually being contained within the compartment. Claim 23 as originally filed had required that the electrode be contained within the compartment (a later element in the claim), but this was deleted in the last response. The requirement has now been restored. For the examiner's convenience, the amendment to claim 23 is shown below (the entire claim is underlined above, in compliance with the format for amendments in reissue applications):

23. (Twice Amended) An electrode package in which one or more adhesively-applied skin electrodes may be sealed, the electrode package comprising:

- an adhesively-applied skin electrode,
- a compartment [sized and configured to enclose] containing the electrode and [to] maintaining the electrode in isolation from an external environment, and
- a connector electrically connected to the electrode, the connector comprising at least one terminal and a connector body supporting the terminal and including a first end exposed to an interior of the compartment and in isolation from the external environment, and a second end isolated from the interior of the compartment when the compartment maintains the electrode in isolation from the external environment, the connector providing an electrically conductive path to the electrode from outside the compartment when the compartment maintains the electrode in isolation from the external environment.

The second broadening noted by the examiner is that claim 23 does not require a releasable seal and a barrier element located at the releasable seal. The examiner is correct that in this respect claim 23 is broadened with respect to original claim 15, and were this the only change with respect to original claim 15, the examiner's recapture rejection might be proper. But claim 23 has been narrowed in another respect, negating any recapture. Claim 23 requires a connector with one end exposed to the interior of the compartment and a second end isolated from the interior (e.g., exposed to the external environment). The actual limitation reads as follows:

- a connector electrically connected to the electrode, the connector comprising at least one terminal and a connector body supporting the terminal and including a first end exposed to an interior of the compartment and in isolation from the external environment, and a second end isolated from the interior of the compartment when the compartment maintains the electrode in isolation from the external environment, the connector providing an electrically conductive path to the electrode from outside the compartment when the compartment maintains the electrode in isolation from the external environment.

One embodiment of the claimed connector element is shown in FIG. 5 of the patent. Connector 116 has a first end exposed to the interior of the compartment and a second end isolated from the compartment. As this embodiment does not have a second compartment

enclosing the second end of the connector, the second end is also exposed to the external environment. If there were a second compartment, then the second end would not be exposed to the external environment. In both situations, the second end would, however, be isolated from the interior of the compartment.

By contrast, the connector element added to claim 15 of the original application was quite different in scope. The element read as follows:

a connector of said first electrode, the connector being exposed to the external environment

The only limitation on the connector is that it be exposed to the external environment. The limitation would, thus, cover a connector dangling at the end of wires extending from the electrode package. By contrast, the connector of claim 23 would not cover such a dangling connector, as the connector in that situation would not have a first end exposed to the interior of the compartment.

The third broadening noted by the examiner relates to the same connector limitation. The examiner indicates that a limitation requiring a connector exposed to the external environment was added to claim 15, and that the connector of claim 23 does not need to be exposed to the external environment.

This is another instance of claim 23 being broadened in one respect but narrowed in another, to negate any recapture. If claim 23 had merely recited a connector, without the requirement that the connector be exposed to an external environment, the examiner might possibly have had a basis for a recapture rejection. But instead, as discussed above, claim 23 has been narrowed in another respect (i.e., to require a connector with a first end exposed to the interior of the compartment, and a second end isolated from the interior of the compartment)..

In summary, claim 23 is not barred by the recapture doctrine, as it has been both broadened and narrowed with respect to original claim 15, and the narrowing is real and significant, and more than sufficient to negate any recapture.

Claims 24-48 and 50-51 are dependent on claim 23 (each adding at least one additional limitation), and so are also not barred by the recapture doctrine.

Applicant : Gary A. Freeman et al.
Serial No. : 08/962,271
Filed : October 31, 1997
Page : 5

Attorney's Docket No.: 04644-068001

The examiner has rejected independent claims 13, 16, and 23 under 35 USC 102(b) as being anticipated by Engel (4,539,996). The examiner is urged to reconsider and withdraw the rejection. Metal connector tab 16 of Engel is not the required "terminal adapted to make and break an electrical connection" (claims 13, 16, and 23). And there is nothing in Engel even remotely suggesting the required "second compartment outside of said first compartment and containing said connector of said first electrode" (claim 13).

The examiner has rejected independent claim 23 under 35 USC 102(b) as being anticipated by Gilman (5,402,884). The examiner is urged to reconsider and withdraw the rejection. Wire leads 132, 135 of Gilman are not the required "terminal adapted to make and break an electrical connection". An insulated wire lead is not adapted to make and break an electrical connection.

The remaining claims are dependent on one or more of the independent claims, and are allowable therewith. Each dependent claim adds one or more limitations that further enhance its patentability, but these limitations are not relied on at present.

The examiner has rejected certain dependent claims under 35 USC 103 as being obvious in light of Gilman combined with Engel. We do not address those rejections, as the claims in question are properly dependent on one of the allowable independent claims (1, 13, 16, or 23).

All of the claims are believed to be in condition for allowance.

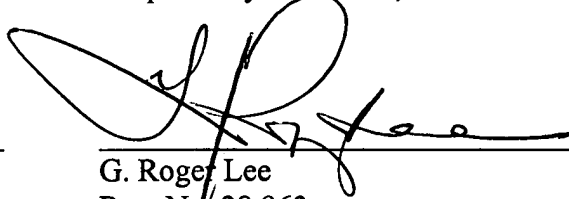
Filed herewith is a Petition for Automatic Extension with the required fee. Please apply any other charges or credits to Deposit Account No. 06-1050.

Applicant : Gary A. Freeman et al.
Serial No. : 08/962,271
Filed : October 31, 1997
Page : 6

Attorney's Docket No.: 04644-068001

Respectfully submitted,

Date: 10/30/00


G. Roger Lee
Reg. No. 28,963

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

20164001.doc